UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,566	01/29/2004	Kiran K. Chada	69014-B/GJG	6434

7590 03/05/2007

Gary J. Gershik
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 11036

EXAMINER	
CHANDRA, GYAN	
ART UNIT	**PAPER NUMBER**
1646	

MAIL DATE	DELIVERY MODE
03/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/768,566	**Applicant(s)** CHADA ET AL.	
	Examiner Gyan Chandra	**Art Unit** 1646	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1, 8-9 and 17-19*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 11 does not place the application in condition for allowance because:

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 USC § 112, second paragraph, 35 USC § 112,first paragraph Written Description and 35 USC § 112,first paragraph-enablement.

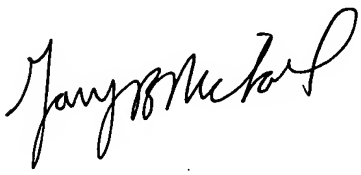
Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8-9, 17 (previously rejected), and 18-19 (new claims) remain rejected under 35 U.S.C. 102(e) as being anticipated by Xu et al (US 2003/0143610) for the reasons of records on pages 11-12 of the office action mailed on 4/9/2006.

Applicants argue (Response, page 5-6) that the Xu et al teachings do not enable the instantly claimed invention. Applicants argue that Xu et al do not describe a method in which sFRP-5 is actually administered to a subject. Applicants argue that Xu et al. method was never practiced, and that necessity requirement of an inherent anticipation is not satisfied (pg. 6, 1st paragraph). Applicants argue that Xu et al cannot anticipate the administration of an amount of sFRP-5 peptide effective to reduce the level of adipose tissue. Applicants argue that Xu et al, in paragraph [0018], provides a generic disclosure of treating metabolic disorders comprising SARP3 modulator wherein the modulator is a SARP3 polypeptide of SEQ ID NO: 2. In support, Applicant provides Exhibit A, which is a copy of May 16,2006 Office Action in Xu et al.

Applicants' arguments have been fully considered but they are not persuasive because Xu et al teach using SARP3 (identical to sFRP-5) for modulating SARP3 mediated metabolic diseases or disorders in a subject (see abstract). Xu et al teach that the metabolic disorders include but not limited to obesity, diabetes, overweight, insulin resistance, anorexia and cachexia (abstract). Further, Xu et al teach that the invention provides methods for modulating lipogenesis and lypolysis in a subject (abstract and [0025]). Therefore, Xu et al anticipate that the administration of polypeptide SARP3 to a subject would modulate lypogenesis and lypolysis and that the polypeptide would treat SARP3 associated metabolic disorders. The Exhibit A which addresses issues regarding the patentability of Xu et al, does still not support the applicant's arguments because Xu et al anticipate using SARP3 for treating SARP3 associated metabolic disorders in a subject. And, since the product of the prior art is identical to that required by the claims, the method will inherently lead to the same therapeutic outcome in a subject. See Ex parte Novitski 26 USPQ 1389 (BPAI 1993). Thus, since the product of the prior art has the same chemical structure as that described in the specification, it can be assumed that the product will inherently perform the claimed process. (See MPEP 2112.02).



GARY B. NICKOL, PH.D.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600